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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,709	10/18/2001	Andrew C. Gilbert	CF/041	8648
64558 7590 02/23/2007 FISH & NEAVE IP GROUP ROPES & GRAY LLP 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			EXAMINER HEWITT II, CALVIN L	
			ART UNIT 3621	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/982,709

Applicant(s)

GILBERT ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5, 10-18, 23-25, 30-34, 39-47, 52-54 and 106-117 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-18, 23-25, 30-34, 39-47, 52-54 and 106-117 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

***Status of Claims***

1. Claims 1-5, 10-18, 23-25, 30-34, 39-47, 52-54 and 106-117 have been examined.

***Examiner's Remarks***

2. Broka et al. teach an interface where a trader can enter both a bid and an offer in a security (figures 18a and b) while, Togher et al. teach a *market maker* interface where a *market maker* makes a bid and an offer of different quantities for the same security, the bid and offer are submitted together, (figures 3 and 5; column 7, lines 20-23 and 35-40; column 11, lines 6-51) and the bid is based on the offer (and vice versa) (column 7, lines 20-23). Applicant is of the opinion that the claims are distinguished from the prior art, as the prior art lacks "generating automatically at least one of a price and a size for an offer to sell the item based on at least one of a price and a size from a bid to buy the item.". Togher et al. clearly state that the intent of a market maker is to have bid price lower than a corresponding offer price, hence the only difference between Applicant's claim 1, for example, and the prior art, is the automatic generation of a sell price in response to a bid. However, it has been held that such a modification of the combined Broka et al. and Togher et al. teachings would have been obvious, as it is not 'invention' to broadly provide an automatic means to replace manual

activity which accomplishes the same result. (*In re Venner*, 120 USPQ 192 (CCPA 1958)).

Limitations directed to what is stored (i.e. displayed) in computer memory (e.g. claim 2) or that merely describe the composition of the data (e.g. claim 4) do not further limit Applicant's claimed method as neither materially affects the steps of "receiving a bid command...", "generating automatically...", "receiving the bid...", and "receiving the offer...".

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "receiving *the* bid to buy the item" (emphasis added). However, prior to the receiving of the bid, the claim also recites "receiving a *bid command*" and generating an offer to sell based on "at least one of a price and a

size *for a bid to buy the item*" (emphasis added). Therefore, to one of ordinary skill it is not clear which bid is received, the bid command or the bid used to generate the sell offer (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)). Claim 30 is also rejected as it recites similar language.

Claims 2-13, 31-42, and 106-117 are also rejected as each depends from either claim 1 or claim 30.

Claim 4 has been amended to recite "the bid command is received *when* the trader selects *the bid price* for the item" (emphasis added). According to claim 1, Applicant's method is initiated by the receiving of a bid command. However, as claim 4 recites "when" it is unclear to one of ordinary skill whether or not the bid command is ever received (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)). Claims 17, 33, and 47 are also rejected as each recites similar language.

Claims 106-110 and 112-116 are also rejected as each depends from either claim 4 or claim 33.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 10-18, 23-25, 30-34, 39-47, 52-54 and 106-117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broka et al., U.S. Patent No. 5,809,483 in view of Togher et al., U.S. Patent No. 5,375,055.

As per claims 1-5, 10-18, 23-25, 30-34, 39-47, 52-54 and 106-117, Broka et al. teach a market trading system comprising:

- receiving a bid command (e.g. data related to a tradable item display) from a trader to buy an item, generating an offer (or bid) based on the submission of a bid (or offer) command from a trader, generating an offer price or size, and receiving the bid and the offer [by the FIPS system] (e.g. generated offer value) (figure 18a)
- using an interactive display, displaying current bid and offer data and receiving a selection of a piece of the bid and offer data as part of the receiving of the bid command (figures 24, 25, and 30; column 16, lines 6-10; column 17, lines 4-14 and 45-67; column/line 19/9-20/6) and selecting a bid (or offer) price from the bid and offer data (i.e. viewing market activity- e.g. bid and offer data, and placing a bid, for example, on a desirable issue at a specific price where the price, or offer, was displayed in the market activity) (figure 18a), displaying the current bid and offer data in a window (figure 20a)
- entering the submission of the bid command via keyboard and using a mouse (column 10, lines 58-63)

- presenting a second trading interface (figures 19 and 20a) that contains information relating to a command (figure 18a) and displaying the interface in response to the reception of a bid (or offer) command (figures 19 and 20a; column 14, lines 6-12 and 33-45)

Broka et al. do not specifically recite submitting an offer command to sell a second size of the item on behalf of the trader wherein the offer is based on the offer value. Togher et al. teach a market maker interface where a market maker makes a bid and an offer of different quantities for the same security, the bid and offer are submitted together, (figures 3 and 5; column 7, lines 20-23 and 35-40; column 11, lines 6-51) and the bid is based on the offer (and vice versa) (column 7, lines 20-23). Togher et al. also teach a screen display for displaying current bid and offer data using a market cell, spread sheet, data window, entry window or webpage (figures 3 and 5). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Broka et al. and Togher et al. in order to accommodate traders using the Broka et al. system ('483, abstract; figures 2, 4, 18a-b, 30 and 39) who desire to take a more active trading role, such as that of a market maker ('055, column 11, lines 6-11)

Regarding, the generating of "offer values", Broka et al. teach quotes as combination "bids" and "asks" (figure 18a; column 4, lines 52-54). Therefore, the Broka et al. system could be used by "market makers" who are willing to buy and

sell a given security at a particular price, "arbitrageurs" seeking to capitalize on price differentials in a security, or market participants executing a trading strategy that involves the simultaneous buying and selling of securities. In each instance, a goal is to turn a profit hence, the second transaction (sell if the initial trade was a buy, or buy if the initial trade was a sale) would be based on the first as both transactions are in the same security. Further, it is well known to those of ordinary skill in the buying and selling of securities to determine a transaction position, and profitability, based on spreads is old and well known.

Regarding the coloring of bid and offer data, Broka et al. teach denoting a piece of data using an asterisk (column 14, lines 55-60) or "highlight" (figure 20a). It has been held that changing the way the system of Broka et al. indicates a dealer's own quote by changing color, for example, would have been an obvious modification to one of ordinary skill (*In re Seid*, 73 USPQ 431, 433 (CCPA 1947))

Regarding "spread sheets", the use of spreadsheets software (e.g. cells, columns, rows) to prepare bids and offers is old and well-known, therefore it would have been obvious to one of ordinary skill to download data such as current market data (figure 18a) in order to construct a profitable bid/offer strategy. Similarly, displaying data remotely using the internet and its associated technologies (e.g. webpages, html, etc.) is also well known.



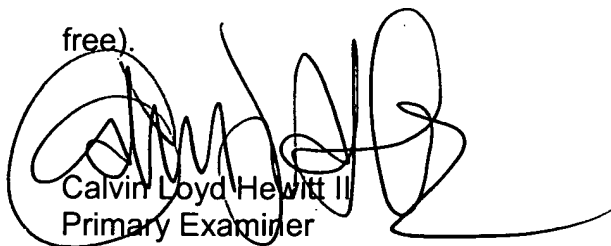
**Conclusion**

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).

  
Calvin Loyd Hewitt II  
Primary Examiner

February 7, 2007